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In re Application of :
Herron : ON PETITION
Application No.: 10/758,618 :
Filed: January 15, 2004 :
Attorney Docket No.: 1776-0015 :

This is in response to the petition under 37 CFR 1.47(b), filed January 15, 2004.

The petition is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

A grantable petition under 37 CFR 1.47(b) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration;
- (2) an acceptable oath or declaration;
- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest; and
- (6) proof of irreparable damage.

This petition lacks items (2), (5), and (6) set forth above.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 has not been presented. While Eugene Palazzo is a registered attorney and is authorized to sign on behalf of Xerox Corporation (Xerox), Xerox has not demonstrated a proprietary interest in the invention. See discussion of item (5) below. As such, the declaration is not acceptable at the moment.

As to item (5), Rule 47 petitioner failed to show or provide proof that Xerox has sufficient proprietary interest in the subject matter to justify the filing of the application (see MPEP 409.03(f)). Acceptable proof would include a copy of the employment agreement between the non-signing inventor and the Rule 47(b) applicant, a copy of an assignment agreement showing that the invention disclosed in the application is assigned to the Rule 47(b) applicant, or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to the Rule 47(b) applicant. Exhibit A to the petition is purportedly a copy of an employment agreement between Mr. Herron and Xerox. Exhibit A is not in the application file. Please submit another copy of Exhibit A with a reconsideration petition.

As to item (6), Rule 47 applicant failed to provide proof of irreparable damage (see MPEP 409.03(g)). A statement by Rule 47 applicant that the filing is necessary to preserve the rights of the parties would be sufficient.

Pursuant to petitioner's authorization, deposit account no. 24-0037 will be charged \$130.00, which was the petition fee due on January 15, 2004.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By FAX: (571) 273-8300 - ATTN: Office of Petitions

Telephone inquiries should be directed to the undersigned at (571) 272-3230.

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